

REMARKS

This request for reconsideration and withdrawal of a restriction requirement under 37 C.F.R. 1.143 is in response to a restriction requirement (Paper No. 20050404) mailed April 8, 2005. Upon entry of this amendment, claims 1-13 and 15-21 will be pending in this application. Applicant has canceled claim 14 without prejudice or disclaimer as to its subject matter by this amendment, has amended claims 1, 2, 3, 5, 6, 9, 10, 15, 16 and 19 by this amendment and has newly added claims 20 and 21 by this amendment.

In Paper No. (20050404) mailed April 8, 2005, the Examiner restricted Applicant's invention as follows:

Group I, claims 1-4 and 10-14 drawn to a plasma display panel, classified in class 313, subclass 582; and

Group II, claims 5-9 and 15-19, drawn to a method of manufacturing the plasma display panel, classified in class 445, subclass 24.

Applicant provisionally elects Group I, drawn to the plasma display panel, with traverse.

Applicant requests withdrawal of the Restriction Requirement of Paper No. 20050404 for the following three reasons:

1. In Paper No. (20050404), the Examiner justifies the restriction requirement under

MPEP 806.05 (f) by saying that Applicant's apparatus of the plasma display panel can be made by another and materially different process. Specifically, the Examiner states that in Paper No. (20050404), "In the instant case as opposed to heating the substrate after the conductive liquid is applied, the substrate could be heated prior to supplying the conductive liquid material." Applicant disagrees.

Applicant submits that if the substrate is heated prior to supplying the conductive liquid, Applicant's claimed structure would not result. This is because the heating serves to bond together the precipitated material into a solid electrode structure. If heat is applied before the conductive liquid is applied, and before the precipitate is allowed to form, the electrodes can not form because there is no precipitate that needs to be bonded together prior to the application of the conductive liquid. The liquid must first be applied and then the conductive particles and the glass frit need to precipitate to the bottom before heat is applied in order to form the claimed electrode structure. This claimed electrode structure would not result if the heat is applied prior to the formation of the precipitate. Therefore, Applicant submits that Applicant's claimed plasma display panel would not result if heat is applied prior to the supplying of the conductive liquid. As a result, Applicant submits that Applicant's novel plasma display panel cannot be made by a materially different process. Therefore, the restriction requirement of Paper No. 20050404 must be withdrawn.

2. In Paper No. 20050404, the Examiner indicated a different classification for

Applicant's method claims than for Applicant's apparatus claims. The Examiner in Paper No. 20050404 then used the alleged separate classification as justification to divide method claims from apparatus claims for the restriction requirement in Paper No. 20050404. Applicant disagrees.

Applicant submits that the classes and subclasses cited by the Examiner are not classified according to method and apparatus. For example, class 313, subclass 582, which the Examiner states is the classification for Applicant's *apparatus* claims, does not pertain only to apparatus claims. Applicant has looked at the patents in this class and subclass and has found the following. For example, US patents 6,876,150, 6870315, 6870314, 6855196, 6833672 and 6833086 are all found in class 313, subclass 582, but all of these patents contain *both* Apparatus and Method of making claims. U.S. Patents 6,800,010, 6,777,872 and 6,860,781 are also found in class 313, subclass 582 but contain only method of making claims and do not contain apparatus claims. Applicant therefore submits that because many of the patents in class 313, subclass 582 contain both apparatus and method claims, it was unnecessary and discriminatory for the Examiner to restrict Applicant's claims as in Paper No. 20050404. Therefore, the restriction requirement of Paper No. 20050404 must be withdrawn.

Because many of the patents issued to class 313, subclass 582 have either *both* method and apparatus claims, or just method claims, Applicant further submits that there would be no undue burden on the part of the Examiner if he were to examine all of Applicant's claims in a

single examination. This is because the prior art search for the method and the apparatus claims is coextensive, and thus the amount of patents and subclasses that need to be investigated by the Examiner is the same regardless of whether all or only some of Applicant's claims were to be examined. In addition to class 313, subclass 582 having many patents with method claims therein, the description of class 313, subclass 582 in the Manual of Classification shows no evidence of excluding the method of making or the apparatus. Because there is no undue burden, and because there is no separate classification for method and apparatus claims, the restriction requirement of Paper No. 20050404 is entirely improper and unjustified.

3. Applicant further traverses the above restriction requirement for the reason that Applicant's apparatus claims and Applicant's method claims are drawn to the same embodiment. This is important because it is a well known tenet of U.S. patent law that claims drawn to a single embodiment may not be restricted from each other. See MPEP 806.03. Since the Examiner is attempting to divide Applicant's claims drawn to the same embodiment, the restriction requirement of Paper No. 20050404 is improper and must be withdrawn.

Addition of Linking claims

In this amendment, Applicant has newly added linking claims 20 and 21. Claim 20 is method claim 5 with apparatus claim 1 depending therefrom. Claim 21 is apparatus claim 1 with claim 5 depending therefrom in a product by process format. Entry of and favorable consideration is requested.

Other Amendments

Applicant has also amended claims 1, 2, 3, 5, 6, 9, 10, 15, 16 and 19 by this amendment to correct for minor errors and to improve the format thereof. Entry of and favorable examination is respectfully requested.

No fees are incurred by the filing of this 37 C.F.R. 1.143 request for reconsideration.

In view of the above, all claims are submitted to be non-dividable and this application is believed to be in condition to be examined in a single examination. Reconsideration and withdrawal of the restriction requirement is requested. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



Robert E. Bushnell,
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

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